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Office Action Date: December 12, 2008

Remarks

Claims 1-27 are pending.

Claims 1 – 6, 10 – 13, 16 – 20 and 23 - 27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Taki (WO 03/061189 stated to correspond to US Pat. No. 7392393) in view of Hori et al. (US Pat. Publ. No. 2002/0131594).

Claims 7 – 9, 14 – 15, 21 and 28 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Taki in view of Hori et al. and further in view of Henrick (WO 02/033026).

Claim 22 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Taki in view of Hori et al. and further in view of Kuriya et al. (US Pat. Publ. No. 2001/0056404).

Claims 1, 4 and 16 have been objected to for lack of antecedent basis for certain language in those claims.

Responsive to the objection to the specification, the specification has been amended as suggested.

Responsive to the objection to the claims because the amended claims were not labeled, applicants note that the claims were not amended by the Preliminary Amendment filed on February 6, 2006. The claims were unchanged from those resulting in the PCT phase. Applicants are not aware that the claims amended during the PCT phase are required to be labeled. In any event, the present response includes a listing of the pending claims including the proper label associated with each claims.

Responsive to the objection of claim 1 as lacking antecedent basis as to "said second information item" applicants note that this element is set forth on line

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7. Responsive to the objections of claims 4 and 16, the subject claims have been amended to provide the necessary antecedent basis. Applicants submit that the objections are overcome in view of the amendment.

Responsive to the rejection of claims 1-6, 10-13, 16-20 and 23-27 under 35 USC 103(a) as being unpatentable over Taki (US 7392393) and Hori (US 2002/0131594), applicants respectfully submit that for the reasons discussed hereinbelow the subject claims are patentably distinguishable over any combination of the cited references.

First, it is submitted that under the published guidelines incorporating the latest Supreme Court decision in *KSR International v. Teleflex, Inc.*, 550 U.S. ____ 127 S. Ct. 1727, 82 USPQ2d 1385, decided April 30, 2007, the Examiner is required to find all elements of the claims in citable references or sources, to identify all missing elements ("ascertain—the differences"); to find such references which teach, suggest and/or motivate the person of ordinary skill to combine such elements in the manner set forth in the rejected claims, and provide a "clear articulation of the reason(s) why the claimed invention would have been obvious." The KSR opinion requires that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". In the absence of references disclosing all of the claimed elements, and the showing of a teaching, suggestion or motivation to combine such claimed elements in the manner claimed, and a clear statement and rational analysis of its basis, an obviousness rejection cannot stand.

The prior art references when combined must teach or suggest all of the claim limitations. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine them as claimed. Finally, there must be a reasonable expectation of success for the proposed combination of elements. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not

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based on the applicant's own disclosure. In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Patent examiners cannot rely on their own knowledge as a basis for rejecting patent applications without the citation of specific evidence (references) having a teaching, suggestion or motivation to modify a reference or to combine two or more references ; In re Lee, 277 F.3d 1338, 1345 (Fed. Cir. 2002).

The examiner bears the burden of establishing a prima facie case of obviousness and "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988, emphasis added).

Absent the elements or the showing of a teaching, suggestion or motivation to combine such elements as claimed, an obviousness rejection cannot stand.

The claimed subject matter is described in the specification as follows.

There are three independent claims, i.e. claims 1, 10 and 16.

The device invention of independent claim 1 is described in paragraphs [0033] through [0035] of the specification, referring to the processing shown and described in connection with Figs. 2 - 4.

Each of independent method claims 10 and 16 includes a recitation of operations corresponding to those performed by the processor of claim 1 in connection with receiving and transmitting secure information content over one or more networks as described, for example, in paragraphs [0006] and [0016] through [0019] of the specification.

Taki, like the present invention, is generally concerned with delivery of information content via network operations in which a content requester (CR) operates a cell phone or other data device to send a request to a content server (CS) to authorize that server to download requested content to a second device, i.e., a content consumer (CC) located at a site "remote" from the content requester. However, the apparatus and method steps disclosed by Taki to implement his system are significantly different from what is set forth in Applicant's claims.

In the rejection, the Examiner has linked together a number of unrelated segments of text that do not describe any particular embodiment disclosed by Taki.

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For example, claim 1 is directed a content consumer, and recites "A device, located at a remote site ---- comprising a processor in communication with a memory ---".

The rejection relies upon "Col. 11, lines 42 – 47, CPU" of Taki for a disclosure of this claim element. However, this portion of Taki is describing a "content requester" (CR) device, which does not perform the subsequent recited method steps of claim 1. Reliance on this portion of the reference to this element is therefore submitted to be unrelated and inappropriate.

Claim 1 goes on to recite:

"receiving a first information item comprising an access code and a content key scrambled using a key known by said remote site,".

The rejection omits any reference to "an access code and a content key" and refers only to col. 3, lines 14 – 31 which describes complex encrypted content-signing key data employed by Taki but not employed or claimed herein. The cited text does not relate to "an access code and a content key" as claimed.

Claim 1 further provides:

"said access code generated by said at least one server in response to a request for a second information item provided by a content requester;" (underlining indicates most recent amendment).

The rejection cites:

"Col. 19, lines 31 – 38, 58 – 64 wherein content distribution server generates content-signing key in response to the request by the mobile information terminal to download content to home PC".

This cited text again fails to disclose any "access code" as claimed.

In addition to the foregoing missing elements of the claim, the Examiner states:

"Taki does not disclose said second information item scrambled using said content key. Taki also does not disclose first information comprising a content key."

In order to fill these gaps, the Examiner attempts to import two unrelated elements from a secondary reference – Hori. The Examiner states:

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"Hori discloses content key (e.g. [0068][0107], encrypted license key) and receiving said second information scrambled using said content key (e.g., [0068] [0085] content data is encrypted with content key)".

Hori simply discloses supplying encrypted music data along with "a license including a license key for decrypting the encrypted content data as information" [0068].

There is nothing, and the Examiner has not pointed out anything, in either Hori or Taki which provides any "teaching, suggestion or motivation" to a person of ordinary skill to modify Taki so as to include:

"receiving a first information item comprising an access code and a content key scrambled using a key known by said remote site."

Additionally, applicants submit that Hori fails to overcome the additional defects of Taki mentioned above as applied to claim 1.

Therefore, there is no basis and no *prima facie* case has been made for a conclusion that the combination of Taki with Hori renders claim 1 obvious.

With regard to independent claim 10, that claim recites:

"receiving a first information item comprising an access code and a content key scrambled using a key known by said remote site,".

The rejection omits any reference to "a content key" and refers only to col. 3, lines 14 – 31 to support a finding of "an access code". That text describes complex encrypted content-signing key data employed by Taki but not employed or claimed herein. The cited text does not relate to "an access code and a content key" as claimed and Taki does not disclose it is such a code.

Claim 10 further provides:

"said access code generated by said at least one server in response to a request for a second information item by a content requester;"
(underlining indicates most recent amendment).

The rejection cites:

"Col. 19, lines 31 – 38, 58 – 64 wherein content distribution server generates content-signing key in response to the request by the mobile information terminal to download content to home PC".

This cited text again fails to disclose any "access code" as claimed.

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In addition to the foregoing missing elements of the claim, the Examiner states:

"Taki does not disclose said second information item scrambled using said content key. Taki also does not disclose first information comprising a content key."

In order to fill these gaps, the Examiner attempts to import two unrelated elements from a secondary reference – Hori. The Examiner states:

"Hori discloses content key (e.g. [0068][0107], encrypted license key) and receiving said second information scrambled using said content key (e.g., [0068] [0085] content data is encrypted with content key)".

Hori simply discloses supplying encrypted music data along with "a license including a license key for decrypting the encrypted content data as information" [0068].

There is nothing, and the Examiner has not pointed out anything, in either Hori or Taki which provides any "teaching, suggestion

"receiving a first information item comprising an access code and a content key scrambled using a key known by said remote site,"

There is no basis and no *prima facie* case has been made for a conclusion that the combination of Taki with Hori renders claim 10 obvious.

With regard to independent claim 16, that claim recites:

"generating a first information containing an access code and a content key at said first server in response to said request for content"

The rejection omits any reference to "a content key" and refers only to col. 2, lines 49 – 64 and col. 12, lines 23 - 39 to support a finding of "an access code". That text describes complex encrypted content-signing key data employed by Taki but not employed or claimed herein. The cited text does not relate to "an access code and a content key" as claimed and Taki does not disclose it is such a code.

Claim 16 further provides:

"transferring said first information item to said designated remote site having a file receiving device, wherein said access code and said content key are scrambled using said encryption key;
receiving said access code from said designated remote site having said file

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receiving device;”.

The reference omits any mention of “a content key” or an “access code”. The Examiner, without any factual basis, alleges the “encrypted key data corresponds to access code and content key” and refers only to col. 13, lines 14 – 18 and col. 12, lines 59 - 63 to support a finding of “an access code”. That text describes complex encrypted content-signing key data employed by Taki.

In order to fill these gaps, the Examiner attempts to import two unrelated elements from a secondary reference – Hori. The Examiner states:

“Hori discloses ----- content key ([0068]), wherein license key is distributed from the distribution server.”.

Hori simply discloses supplying encrypted music data along with “a license including a license key for decrypting the encrypted content data as information” [0068].

There is nothing, and the Examiner has not pointed out anything, in either Hori or Taki which provides any “teaching, suggestion or motivation for combining those references in any way.

There is no basis and no *prima facie* case has been made for a conclusion that the combination of Taki with Hori renders claim 16 obvious.

Each of the remaining claims, that is claims 2 – 9, 11 – 15 and 17 – 28 are dependent on one of the three independent claims discussed above and are submitted to be patentable based on the patentability of their parent claims as set forth above.

With respect to the rejection of claims 7 – 9, 14 – 15, 21 and 23 under 35 U.S.C. § 103(a) based on Taki in view of Hori and further in view of Horick, it is respectfully submitted that neither of the first two references provides any disclosure or suggestion of significant claim elements as pointed out above. Additionally, Horick, even assuming arguendo that it provides the additional teachings as alleged, still fails to overcome the defect of Taki and Hori as applied to the independent claims 1, 10, and 16. As such, applicants respectfully submit that the subject claims are patentably distinguishable over the cited combination of references.

With respect to the rejection of claim 22 under 35 U.S.C. § 103(a) based on Taki in view of Hori and further in view of Kuriya, it is respectfully submitted that neither of the first two references provides any disclosure or

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suggestion of significant claim elements as pointed out above. Additionally, Horick, even assuming *arguendo* that it provides the additional teachings as alleged, still fails to overcome the defect of Taki and Hori as applied to the independent claims 1, 10, and 16. As such, applicants respectfully submit that the subject claims are patentably distinguishable over the cited combination of references.

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Accordingly, Applicant requests that the Examiner's rejection be withdrawn as to each of claims 1 – 28, that such claims be allowed as indicated and that the application be held to be in condition for allowance.

Respectfully submitted,

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